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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,891	01/05/2001	Steven D. Ims	RSW920000077US	4751

25259 7590 02/17/2006

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EXAMINER

BOTTS, MICHAEL K

ART UNIT PAPER NUMBER

2176

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/754,891

Applicant(s)

IMS ET AL.

Examiner

Michael K. Botts

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>December 14, 2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This document is the first Office Action on the merits. This action is responsive to the following communications: The Non-Provisional Application, which was filed on January 5, 2001, The Information Disclosure Statement (IDS), which was also filed on January 5, 2001, and acknowledgment is made of a Change of Address, which was filed on December 14, 2005.
2. Claims 1-30 have been examined, with claims 1, 8, 15, 22, 23, 25, and 27 being the independent claims.
3. The Abstract is objected to.
4. Claims 1-30 are rejected.

Information Disclosure Statement

5. An initialed and dated copy of applicant's IDS form 1449, which was filed on January 5, 2001, is attached to this Office Action.

Abstract of the Disclosure

6. The abstract of the disclosure is objected to because it is too long. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The Specification

7. Applicant is required to update the status (pending, allowed, etc.) of all parent priority applications in the first line of the specification. The status of all citations of U.S. filed applications in the specification should also be updated where appropriate.

8. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claims Rejections – 35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-30 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by “e”speak Tutorial, Version: Beta 20.2” Hewlett-Packard Company, December 1999 [hereinafter “E-Speak”].

Regarding **independent claim 1**, E-Speak teaches:

A computer program product for automated e-business services, the computer program product embodied on one or more computer-readable media of a first computing system and comprising:

computer-readable program code means for reading a specification of an e-business service; and

computer-readable program code means for processing the specification to carry out the e-business service, further comprising:

computer-readable program code means for receiving one or more input documents for the e-business service; and

computer-readable program code means for performing one or more of (1) transforming the input documents into other documents,

according to transformation information that may be provided in the specification, and (2) operating upon the input documents and/or the other documents to create one or more new documents, according to operating actions that may be provided in the specification.

(It is noted that the term “specification” is not defined in the specification. E-Speak defines “specification” as follows: “The events-service specification defines two interfaces. Namely, ListenerIntf: It defines the format of event notifications. DistributorIntf: It defines the format of publish and subscribe requests.” See, E-Speak, page 35-36. The E-Speak definition is consistent with the use of that term in this application, and, accordingly, the E-Speak definition of “specification” will be used in this Office Action.

It is further noted that the term “service” is not specifically defined in the specification. E-Speak defines “service” as follows: “A **service** is essentially a program written in a programming language. A service adheres to its **contract** and its **vocabulary**. **Service Contracts**: A contract defines the set of interfaces that a service implements. Contracts can be discovered and used just like any other service. **Service Vocabularies**: A vocabulary consists of a set of attributes and associated properties. Vocabularies can be discovered and used just like any other service.” See, E-Speak, page 5 [emphasis and bold in the original]. The E-Speak definition is consistent with the use of that term in this application, and, accordingly, the E-Speak definition of “service” will be used in this Office Action.

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E-Speak contains code for reading and processing a specification of an e-business service. See, E-Speak, pages 35-40.

E-Speak will receive an XML document and transform the input into a DOM document. See, E-Speak, pages 76-77.)

Regarding **dependent claim 2**, E-Speak teaches:

The computer program product according to claim 1, further comprising computer-readable program code means for forwarding the other documents and/or the new documents to a computing system other than the first computing system.

(See, E-Speak, page 81, teaching that the E-Speak service provider's advertisements are automatically transferred to all the advertising services belonging to the same group.)

Regarding **dependent claim 3**, E-Speak teaches:

The computer program product according to claim 1, wherein the specification and the input documents are encoded in a structured markup language.

(See, E-Speak, pages 76-77, teaching that the input documents are encoded in a structured markup language of XML.)

Regarding **dependent claim 4**, E-Speak teaches:

The computer program product according to claim 1, wherein the other documents and the new documents are encoded in a structured markup language.

(See, E-Speak, pages 76-77, teaching that the input documents are encoded in a structured markup language of XML.)

Regarding **dependent claim 5**, E-Speak teaches:

The computer program product according to claim 3 or claim 4, wherein the structured markup language is a language known as "the Extensible Markup Language (XML)" or a derivative thereof.

(See, E-Speak, pages 71-72 and 76-77, teaching that the input documents are encoded in a structured markup language of XML and a DOM.)

Regarding **dependent claim 6**, E-Speak teaches:

The computer program product according to claim 1, wherein the computer-readable program code means for operating upon the input documents and/or the other documents further comprises:

computer-readable program code means for invoking one or more software-implemented processes; and

computer-readable program code means for coordinating results of the invocations.

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(See, E-Speak, page 10, teaching the invocation of the *start()* process.)

Regarding **dependent claim 7**, E-Speak teaches:

The computer program product according to claim 6, further comprising computer-readable program code means for repetitively executing the computer-readable program code means for processing, until reaching a final result of the e-business service, wherein the other documents, the new documents, and/or the coordinated results of the invocations now function as the input documents.

(See, E-Speak, page 81, teaching that the E-Speak service provider's advertisements are automatically transferred repeatedly to all the advertising services belonging to the same group.)

Regarding **claims 8-14**, claims 8-14 incorporate substantially similar subject matter as claimed in claims 1-7, respectively, and are rejected along the same rationale.

Regarding **claims 15-21**, claims 15-21 incorporate substantially similar subject matter as claimed in claims 1-7, respectively, and are rejected along the same rationale.

Regarding **independent claim 22**, E-Speak teaches:

A method of conducting business by using automated e-business services, comprising steps of:

reading a specification of an e-business service; and

processing the specification to carry out the e-business service, further comprising steps of:

receiving one or more input documents for the e-business service;

and

performing one or more of: (1) transforming the input documents into other documents, according to transformation information that may be provided in the specification, and (2) operating upon the input documents and/or the other documents to create one or more new documents, according to operating actions that may be provided in the specification.

(It is noted that the term "specification" is not defined in the specification. E-Speak defines "specification" as follows: "The events-service specification defines two interfaces. Namely, ListenerIntf: It defines the format of event notifications. DistributorIntf: It defines the format of publish and subscribe requests." See, E-Speak, page 35-36. The E-Speak definition is consistent with the use of that term in this application, and, accordingly, the E-Speak definition of "specification" will be used in this Office Action.

It is further noted that the term "service" is not specifically defined in the specification. E-Speak defines "service" as follows: "A **service** is essentially a program written in a programming language. A service adheres to its **contract** and its **vocabulary**. **Service Contracts**: A contract defines the set of interfaces that a service implements. Contracts can be discovered and used just like any other service. **Service Vocabularies**: A vocabulary consists of a set of attributes and associated properties.

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Vocabularies can be discovered and used just like any other service.” See, E-Speak, page 5 [emphasis and bold in the original]. The E-Speak definition is consistent with the use of that term in this application, and, accordingly, the E-Speak definition of “service” will be used in this Office Action.

E-Speak contains code for reading and processing a specification of an e-business service. See, E-Speak, pages 35-40.

E-Speak will receive an XML document and transform the input into a DOM document. See, E-Speak, pages 76-77.)

Regarding **independent claim 23**, E-Speak teaches:

A method of defining e-business process and data interactions, further comprising steps of:

defining data inputs to be used by an e-business service;

defining interactions to be carried out when operating the e-business service;

specifying details of the data inputs in a structured markup language syntax;

specifying details of the interactions in the structured markup language syntax; and

creating one or more e-business service definition documents wherein the specified details of the data inputs and the specified details of the interactions are recorded.

(It is noted that the term "specification" is not defined in the specification. E-Speak defines "specification" as follows: "The events-service specification defines two interfaces. Namely, ListenerIntf: It defines the format of event notifications. DistributorIntf: It defines the format of publish and subscribe requests." See, E-Speak, page 35-36. The E-Speak definition is consistent with the use of that term in this application, and, accordingly, the E-Speak definition of "specification" will be used in this Office Action.

It is further noted that the term "service" is not specifically defined in the specification. E-Speak defines "service" as follows: "A **service** is essentially a program written in a programming language. A service adheres to its **contract** and its **vocabulary**. **Service Contracts**: A contract defines the set of interfaces that a service implements. Contracts can be discovered and used just like any other service. **Service Vocabularies**: A vocabulary consists of a set of attributes and associated properties. Vocabularies can be discovered and used just like any other service." See, E-Speak, page 5 [emphasis and bold in the original]. The E-Speak definition is consistent with the use of that term in this application, and, accordingly, the E-Speak definition of "service" will be used in this Office Action.

E-Speak contains code for reading and processing a specification of an e-business service. See, E-Speak, pages 35-40.

E-Speak will receive an XML document and transform the input into a DOM document. See, E-Speak, pages 76-77.

See, E-Speak, page 5, teaching that a contract service is used to create and use documents as contrasts.)

Regarding **dependent claim 24**, E-Speak teaches:

The method according to claim 23, wherein the structured markup language is a language known as "the Extensible Markup Language (XML)" or a derivative thereof.

(See, E-Speak, pages 71-72 and 76-77, teaching that the input documents are encoded in a structured markup language of XML and a DOM.)

Regarding **independent claim 25**, E-Speak teaches:

A method of defining process and data interactions for an application described by a finite state machine, further comprising steps of:

defining data inputs to be used by the application;

defining interactions to be carried out when operating the application;

specifying details of the data inputs in a structured markup language syntax;

specifying details of the interactions in the structured markup language syntax; and

creating one or more application definition documents wherein the specified details of the data inputs and the specified details of the interactions are recorded.

(It is noted that the term “specification” is not defined in the specification. E-Speak defines “specification” as follows: “The events-service specification defines two interfaces. Namely, ListenerIntf: It defines the format of event notifications. DistributorIntf: It defines the format of publish and subscribe requests.” See, E-Speak, page 35-36. The E-Speak definition is consistent with the use of that term in this application, and, accordingly, the E-Speak definition of “specification” will be used in this Office Action.

It is further noted that the term “service” is not specifically defined in the specification. E-Speak defines “service” as follows: “A **service** is essentially a program written in a programming language. A service adheres to its **contract** and its **vocabulary**. **Service Contracts**: A contract defines the set of interfaces that a service implements. Contracts can be discovered and used just like any other service. **Service Vocabularies**: A vocabulary consists of a set of attributes and associated properties. Vocabularies can be discovered and used just like any other service.” See, E-Speak, page 5 [emphasis and bold in the original]. The E-Speak definition is consistent with the use of that term in this application, and, accordingly, the E-Speak definition of “service” will be used in this Office Action.

E-Speak contains code for reading and processing a specification of an e-business service. See, E-Speak, pages 35-40.

E-Speak will receive an XML document and transform the input into a DOM document. See, E-Speak, pages 76-77.

See, E-Speak, page 5, teaching that a contract service is used to create and use documents as contrasts.

See, E-Speak, pages 71-72 and 76-77, teaching that the input documents are encoded in a structured markup language of XML and a DOM.)

Regarding **dependent claim 26**, E-Speak teaches:

The method according to claim 25, wherein the structured markup language is a language known as "the Extensible Markup Language (XML)" or a derivative thereof.

(See, E-Speak, pages 71-72 and 76-77, teaching that the input documents are encoded in a structured markup language of XML and a DOM.)

Regarding **independent claim 27**, E-Speak teaches:

A method performed by one or more computers for automating data and process interactions between a first application and one or more other applications, comprising steps of:

providing one or more application definition documents encoded in a structured markup language, wherein the application definition documents specify the interactions and one or more data inputs to be used in the interactions, and wherein details of the specified interactions and data inputs are specified in the structured markup language; and

processing the application definition documents to carry out the data and process interactions.

(See, E-Speak, pages 75-77, teaching the providing and processing of documents in XML with specified interactions and data inputs in XML.)

Regarding **dependent claim 28**, E-Speak teaches:

The method according to claim 27, wherein the step of processing the application definition documents further comprises steps of:

receiving one or more input documents to be used by the interactions; and performing one or more of (1) transforming the input documents into other documents, according to transformation information that may be provided in the application definition documents, and (2) operating upon the input documents and/or the other documents to create one or more new documents, according to operating actions that may be provided in the application definition documents.

(See, E-Speak, pages 76-77, teaching that E-Speak will receive an XML document and transform the input into a DOM document.)

Regarding **dependent claim 29**, E-Speak teaches:

The method according to claim 28, further comprising the step of forwarding the other documents and/or the new documents to from one or the computers to another of the computers.

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(See, E-Speak, page 81, teaching that the E-Speak service provider's advertisements are automatically transferred to all the advertising services belonging to the same group.)

Regarding **dependent claim 30**, E-Speak teaches:

The method according to claim 27, wherein the structured markup language is a language known as "the Extensible Markup Language (XML)" or a derivative thereof.

(See, E-Speak, pages 76-77, teaching that E-Speak will receive an XML document and transform the input into a DOM document.)

10. It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art.

See, MPEP 2123.

Conclusion

11. The following prior art is made of record and not relied upon that is considered pertinent to applicants' disclosure:

Karp, et al. (U.S. Patent 6,493,712 B1), teaching a self-describing attribute vocabulary to be used in a system such as business-to-business.

Karp, et al. (U.S. Patent 6,205,466 B1), teaching a business-to-business system using meta-data.

Karp, et al. (U.S. Patent Application Publication 2003/0154171 A1), teaching a system of authentication for use in an online business system.

Karp, et al. (U.S. Patent Application Publication 2002/0120704 A1), teaching a common computer language for business.

Karp, A., "E-speak E-xplained," Hewlett-Packard Company, July 31, 2000, teaching an overview of E-Speak.

Winsor, G., "The E-services Revolution – the next evolution of the Internet," Hewlett-Packard, December 6, 2000, power-point slide overview of E-Speak with graphics.

W3C, "Authoring Tool Accessibility Guidelines 1.0," October 26, 1999, teaching guidelines for web authoring.

Balakrishnan, R., "A Service Framework Specification for Dynamic e-services interaction," Hewlett-Packard Co., 2000, teaching integration of e-service systems.

"Cocoon, version 1.6-dev." Java Apache Project, downloaded by the Examiner on February 10, 2006 from:

<http://web.archive.org/web/19991111100042/java.apache.org/cocoon/index.html> (and linked pages), downloaded pages 1-61, teaching an open source program with the same functionality claimed in the application.

La Quey, R., "SML: Simplifying XML," XML.com, November 24, 1999, downloaded from www.xml.com/print/1999/11/sml/index.html, pages 1-5, teaching a

simplified SML language which incorporates some of the functions claimed in the application.

“VerticalNet OSM Platform, Service Publisher User’s Guide, Preview Release,” VerticalNet Solutions, VerticalNet, December 31, 2000, cover, copyright, and contents pages, pages 1-36, teaching a software program incorporating the same functionality as claimed in the application.

Individuals associated with the filing or prosecution of a patent application are reminded of their obligations pursuant to 37 CFR 1.56. See generally, MPEP 2001 and subsections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael K. Botts whose telephone number is 571-272-5533. The examiner can normally be reached on Monday Thru Friday 8:00-4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MKB/mkb

A handwritten signature in black ink, appearing to read "Doug Hutton", written in a cursive style.

**DOUG HUTTON
PRIMARY EXAMINER
TECH CENTER 2100**